



06-30-03

#14  
S. A. E.  
7/12/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

3 Applicant: Gorkem I. Ates  
4 Series Code/Serial No.: 09/401,221 Filed: September 22, 1999  
5 Group Art Unit: 2152 Paper No.: 14  
6 Invention: INTERNET SYSTEM  
7 Examiner: Hai V. Nguyen Agent's Doc. No.: ATEG21A  
8 As article No.: EL586862255US EXPRESS MAIL I hereby certify,  
9 that on the below indicated date, this correspondence is being  
10 deposited with the United States Postal Service with  
11 sufficient postage in an envelope addressed to the:  
12 Commissioner for Patents, P.O. BOX 1450, VA 22313-1450.

13 Mail Stop Appeal Brief-Patents  
14 Commissioner for Patents  
15 P.O. BOX 1450  
16 ALEXANDRIA, VA 22313-1450

BY: Richard L. Miller  
Agent for Applicant  
Date: JUNE 27, 2003

RECEIVED  
JUL 03 2003

17 REPLY BRIEF UNDER 1.193 Technology Center 2100  
18 Sir:  
19 Applicant responds to the Examiner's Answer dated May 2,  
20 2003, and files the instant Reply Brief in triplicate.

1     In the Claims:

2     1.     (original) An Internet system, comprising:

3           a)     a main server for storing information to be  
4                   requested over the Internet by a client so as to  
5                   form a request for information and having an IP  
6                   address; and

7           b)     at least one participant server having an IP  
8                   address and electrically communicating with said  
9                   main server; said at least one participant server  
10                  not receiving the request for information from the  
11                  client, but rather said main server receiving the  
12                  request for information over the Internet from the  
13                  client and requesting over the Internet that said  
14                  at least one participant server send the requested  
15                  information over the Internet back to the client,  
16                  and if said at least one participant server does  
17                  not have the requested information, the requested  
18                  information is downloaded from said main server to  
19                  said at least one participant server, and when said  
20                  at least one participant server sends the requested  
21                  information over the Internet back to the client,  
22                  said at least one participant server assigns to the  
23                  requested information said IP address of said main  
24                  server and not said IP address of said at least one  
25                  participant server.

26     2.     (original) The system as defined in claim 1, wherein said  
27              main server is a TCP/IP server and assign jobs to said  
28              at least one participant server dynamically without  
29              relocating the client using neither HTTP nor HTML

1 commands so as to take relocating process away from top  
2 networking OSI layers to 3rd level of Internet working  
3 OSI that is IP so as to enable starting downloading of  
4 the requested information from one of said at least one  
5 participant servers and finishing the downloading from  
6 another of said at least one participant server without  
7 ever noticing server alteration by virtue of said at  
8 least one participant server assigning to the requested  
9 information said IP address of said main server and not  
10 said IP address of said at least one participant server.

11 3. (original) The system as defined in claim 2, wherein said  
12 top networking OSI is at least one of TCP, HTTP, and  
13 application level.

14 4. (currently amended) A method for using an Internet  
15 system, comprising the steps of:  
16 a) making a request for information, over the  
17 Internet, by a client, to a main server of the  
18 Internet system and not to said at least one  
19 participant server;  
20 b) examining an IP address of the client, by said main  
21 server;  
22 c) seeking at least one participant server of the  
23 Internet system, by said main server, so as to form  
24 an at least one nearest participant server;  
25 d) requesting over the Internet, by said main server  
26 acting like an orchestra leader, that said at least  
27 one nearest participant server send the requested  
28 information to the client, packet-by-packet, over  
29 the Internet;

1 e) determining if said at least one nearest  
2 participant server has the requested information;  
3 f) labeling, by said at least one nearest participant  
4 server, each packet with an IP address of said main  
5 server, which enables the client which has a port  
6 open only for main server addresses to accept said  
7 packets, if answer to step e) is yes;  
8 g) sending the requested information with said IP  
9 address of said main server, by said at least one  
10 nearest participant server, to the client, over the  
11 Internet;  
12 h) downloading the requested information from said  
13 main server to said at least one nearest  
14 participant server, which will distribute the load  
15 of said main server to said at least one  
16 participant server when lacking multicasting so as  
17 to save costs, by virtue of said at least one  
18 participant server being relatively easy and  
19 inexpensive to add as compared to clustering more  
20 servers to said main server, if answer to STEP 5 e)  
21 is no; and  
22 i) returning to step f).

23 5. (original) The method as defined in claim 4, wherein said  
24 step of making a request for information, over the  
25 Internet, by the client, from the main server includes  
26 making the request for at least one of a streaming video  
27 and an audio, over the Internet, by the client, from the  
28 main server.

1     6.     (original) The method as defined in claim 4, wherein said  
2           step of seeking the nearest at least one participant  
3           server, by said main server, so as to form an at least  
4           one nearest participant server includes seeking the  
5           nearest at least one nearest participant server, by said  
6           main server, so as to form said at least one nearest  
7           participant server that has the most bandwidth and CPU  
8           and other serving requirements needed to furnish the  
9           requested information to the client.

1

REMARKS

2

Claim 4 has been currently amended.

3

4

Applicant respectfully requests further examination and reconsideration of claims 1-6 still pending in the application.

5

6

7

The last Office Action dated May 2, 2003 has been carefully considered and indicates that:

8

9

10

11

12

13

14

15

16

17

18

a) Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and

19

20

21

22

23

24

25

b) Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al. in view of Leighton et al.

26

27

28

29

30

31

32

In response to the Examiner's rejection of claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, applicant has amended claim 4, line 29, to change "5" to --e)--.

33

34

35

In view of the amendment made supra to claim 4, line 29, to change "5" to --e)--, applicant respectfully submits that the Examiner's grounds for the rejection of claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing

1 to particularly point out and distinctly claim the subject  
2 matter which applicant regards as the invention are no longer  
3 tenable and applicant therefore respectfully requests that the  
4 Examiner withdraw this rejection.

5 In response to the Examiner's rejection of claims 1-6  
6 under 35 U.S.C. 103(a) as being unpatentable over Bendel et  
7 al. in view of Leighton et al., applicant respectfully submits  
8 that pursuant to 37 CFR 1.111(c), claims 1 and 4 define the  
9 following advantageous distinctive features, that distinguish  
10 over, and avoid, the prior art:

11 a) "...said main  
12 server... requesting  
13 over the Internet  
14 that said at least  
15 one participant  
16 server send the  
17 r e q u e s t e d  
18 information over the  
19 Internet back to the  
20 client..."[claim  
21 1][Emphasis added];

22 b) "...if said at least  
23 one participant  
24 server does not have  
25 the requested  
26 information, the  
27 r e q u e s t e d  
28 information is  
29 downloaded from said  
30 main server to said  
31 at least one  
32 p a r t i c i p a n t  
33 server..."[claim 1]  
34 [Emphasis added];

35 c) "requesting over the  
36 Internet, by said  
37 main server acting  
38 like an orchestra  
39 leader, that said at  
40 least one nearest

1 participant server  
2 send the requested  
3 information over the  
4 Internet back to the  
5 client..."[claim  
6 4][Emphasis added];  
7 and

8 d) "downloading the  
9 r e q u e s t e d  
10 information from  
11 said main server to  
12 said at least one  
13 nearest participant  
14 server, which will  
15 distribute the load  
16 of said main server  
17 to said at least one  
18 participant server  
19 when lacking  
20 multicasting so as  
21 to save costs, by  
22 virtue of said at  
23 least one  
24 participant server  
25 being relatively  
26 easy and inexpensive  
27 to add as compared  
28 to clustering more  
29 servers to said main  
30 server"[claim 4]  
31 [Emphasis added].

32 It was decided in In re Miller, 169 USPQ 597 (CCPA 1971)  
33 that each and every limitation, inter alia those discussed  
34 supra, must be met in determining patentability:

35 "All words in a  
36 claim must be  
37 considered in  
38 judging the  
39 patentability of  
40 that claim against  
41 the prior art."[at  
42 600][Emphasis added]



1 In this same regard, the Examiner's attention is  
2 respectfully directed to the decisions in In re Fuetterer, 138  
3 USPQ 217 (CCPA 1963); and In re Ludke and Sloan, 169 USPQ 563  
4 (CCPA 1971).

5 When the Internet system of the present invention is  
6 designed in accordance with the advantageous distinctive  
7 features of claims 1 and 4 discussed supra, inter alia:

8 1. The at least one participant server can be located  
9 anywhere in the world regardless of where in the world  
10 the main server is located ipso facto "...said main  
11 server... requesting over the Internet that said at least  
12 one participant server send the requested information  
13 over the Internet back to the client..."[claim  
14 1][Emphasis added] and "requesting over the Internet, by  
15 said main server acting like an orchestra leader, that  
16 said at least one nearest participant server send the  
17 requested information over the Internet back to the  
18 client..."[claim 4][Emphasis added], as opposed to the  
19 main server communicating with the at least one  
20 participant server over a discrete and/or distinct and/or  
21 dedicated connection.

22 2. Costly multicasting [the at least one participant server  
23 is relatively easy and inexpensive to add as compared to  
24 clustering more servers to the main server] is not  
25 required if the at least one participant server does not  
26 contain the requested information ipso facto "...if said  
27 at least one participant server does not have the  
28 requested information, the requested information is  
29 downloaded from said main server to said at least one  
30 participant server..."[claim 1][Emphasis added] and  
31 "downloading the requested information from said main

1 server to said at least one nearest participant server,  
2 which will distribute the load of said main server to  
3 said at least one participant server when lacking  
4 multicasting so as to save costs, by virtue of said at  
5 least one participant server being relatively easy and  
6 inexpensive to add as compared to clustering more servers  
7 to said main server"[claim 4] [Emphasis added].

8 Even though the advantageous features of the present  
9 invention discussed supra may not have been disclosed and  
10 discussed specifically in the specification of the patent  
11 application as it was originally filed, they still must be  
12 relied upon as evidence of patentability, as was decided in  
13 In re Chu, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995),  
14 where the Court held:

15 "Board of Patent  
16 Appeals and  
17 Interferences erred,  
18 in upholding  
19 obviousness  
20 rejection of  
21 applicant's claims,  
22 by concluding that  
23 claims' disclosure  
24 was matter of  
25 "design choice," and  
26 that the applicant's  
27 evidence and  
28 arguments to  
29 contrary are not  
30 present in  
31 specification and  
32 are therefore  
33 unpersuasive, since  
34 board is required to  
35 consider totality of  
36 record and is not  
37 free to disregard  
38 evidence and  
39 arguments presented  
40 by applicants, and

1                   since there is no  
2                   support for  
3                   proposition that  
4                   evidence and/or  
5                   arguments traversing  
6                   35 USC 103 rejection  
7                   must be contained  
8                   w i t h i n  
9                   specification, given  
10                  that obviousness is  
11                  determined by  
12                  totality of record  
13                  including, in some  
14                  instances most  
15                  significantly,  
16                  evidence and  
17                  arguments proffered  
18                  during give-and-take  
19                  of ex parte patent  
20                  prosecution." [at  
21                  1090]     [Emphasis  
22                  added]

23                  "Because the Board  
24                  was required to  
25                  consider the  
26                  totality of the  
27                  record, the Board  
28                  was not free to  
29                  disregard the  
30                  evidence and  
31                  arguments presented  
32                  by Chu in response  
33                  to the obviousness  
34                  r e j e c t i o n .  
35                  Additionally, the  
36                  Board erred in  
37                  apparently requiring  
38                  Chu's evidence and  
39                  arguments responsive  
40                  to the obviousness  
41                  rejection to be  
42                  w i t h i n h i s  
43                  specification in  
44                  order to be  
45                  considered. To  
46                  require Chu to

1 include evidence and  
2 arguments in the  
3 specification  
4 regarding whether  
5 placement of the SCR  
6 catalyst in the bag  
7 retainer was a  
8 matter of "design  
9 choice" would be to  
10 require patent  
11 applicants to divine  
12 the rejections the  
13 PTO will proffer  
14 when patent  
15 applications are  
16 filed. " [at  
17 1094] [Emphasis  
18 added]

19 "We have found no  
20 cases supporting the  
21 position that a  
22 patent applicant's  
23 evidence and/or  
24 arguments traversing  
25 a § 103 rejection  
26 must be contained  
27 within the  
28 specification.  
29 There is no logical  
30 support for such a  
31 proposition as well,  
32 given that  
33 obviousness is  
34 determined by the  
35 totality of the  
36 record including, in  
37 some instances, most  
38 significantly, the  
39 evidence and  
40 arguments proffered  
41 during the give-and-  
42 take of ex parte  
43 p a t e n t  
44 prosecution." [at  
45 1095] [Emphasis  
46 added]

1 And, even though the present invention may be considered  
2 simple and accomplishes only a small but genuine improvement  
3 by some is not sufficient reason to deny it patent protection,  
4 as was decided in Schnell et al. v. The Allbright-Nell Company  
5 et al., 146 USPQ 322 (Court of Appeals, Seventh Circuit 1965),  
6 where the Court held:

7 "Device seems simple  
8 and obvious in light  
9 of patentee's  
10 teaching, but it  
11 evidently was not  
12 obvious at time of  
13 invention; those  
14 working in the field  
15 did not accomplish  
16 patentee's results;  
17 that fact supports  
18 conclusion that  
19 patentee achieved  
20 p a t e n t a b l e  
21 invention." [at  
22 322] [Emphasis added]

23 "This now seems  
24 simple and obvious  
25 in the light of the  
26 Schnell teaching,  
27 but is was evidently  
28 not at all obvious  
29 at the time of the  
30 invention. Those  
31 working in the field  
32 did not accomplish  
33 Schnell's results.  
34 That fact supports  
35 the conclusion that  
36 Schnell achieved  
37 p a t e n t a b l e  
38 inventions. Pyle  
39 Nat. Co. v. Lewin, 7  
40 Cir., 1937, 92 F.2d  
41 628, 630, 35 USPQ  
42 40, 42." [at 324]  
43 [Emphasis added]

1           The Board of Appeals expressed the same concept when it  
2 held in Ex parte Grasenick and Gessner, 158 USPQ 624 (Patent  
3 Office Board of Appeals 1967), that:

4                   "Improvement       over  
5                   prior art, even  
6                   though it be simple  
7                   or involves only a  
8                   reversing of certain  
9                   parts, is patentable  
10                  unless prior art  
11                  shows that  
12                  improvement is  
13                  obvious." [at 624]  
14                  [Emphasis added]

15                 "This rejection is  
16                 in error. An  
17                 improvement over the  
18                 prior art, even  
19                 though it be simple  
20                 or involves only a  
21                 reversing of certain  
22                 parts, is patentable  
23                 unless the prior art  
24                 shows the  
25                 improvement to be  
26                 obvious. The  
27                 examiner has neither  
28                 cited evidence  
29                 establishing the  
30                 obviousness of  
31                 a p p e l l a n t ' s  
32                 modification of the  
33                 prior art nor  
34                 demonstrated that  
35                 the improved results  
36                 c l a i m e d       by  
37                 appellants are not  
38                 available from their  
39                 construction." [at  
40                 624]       [Emphasis  
41                 added]

42                 Attention is also respectfully directed in this regard  
43 to the decisions in Mercantile National Bank of Chicago et al

1 v. Quest, Inc. et al. DC., N.D. Indiana, 166 USPQ 517; In re  
2 Shelby, 136 USPQ 220; and In re Irani and Moedritzer, 166 USPQ  
3 24, which all indicate that simplicity does not operate as a  
4 bar to patentability if the invention was unobvious at the  
5 time it was made.

6 Turning now to the references, and with regard to  
7 advantageous distinctive features a) and c) of claims 1 and  
8 4, respectively, discussed supra, contrary to the Examiner's  
9 statements made at page 1, paragraph 1, lines 1-2 and at page  
10 3, paragraph 6, lines 1-3, respectively, of the last Office  
11 Action, Brendel et al. does not teach "...said main server...  
12 requesting over the Internet that said at least one  
13 participant server send the requested information over the  
14 Internet back to the client..." [claim 1][Emphasis added] or  
15 "requesting over the Internet, by said main server acting like  
16 an orchestra leader, that said at least one nearest  
17 participant server send the requested information over the  
18 Internet back to the client..."[claim 4][Emphasis added], but  
19 rather teaches that the load balancer 70 (relied upon by the  
20 Examiner at page 3, paragraph 6, lines 3-4 of the last Office  
21 Action as the main server of the present invention)  
22 communicates with a server 52 over the discrete and/or  
23 distinct and/or dedicated connection 120 that is independent  
24 of Internet 66, as shown in figure 8 of Brendel et al.

25 With this arrangement of Brendel et al., the server 52  
26 cannot be located anywhere in the world regardless of where  
27 in the world the load balancer 70 is located ipso facto the  
28 load balancer 70 communicates with the server 52 over the  
29 discrete and/or distinct and/or dedicated connection 120.

30 Additionally, Brendel et al. disclose at col. 20, lines  
31 34-37:

1 "The web farm has  
2 been described as  
3 having a "local"  
4 network, but this  
5 local network could  
6 be local only in the  
7 sense that it is not  
8 the Internet  
9 backbone."

10 Brendel et al. teach communicating between the scheduler  
11 and the server with a proprietary (OSI 3rd level) protocol  
12 called IXP.

13 In contradistinction, the present invention teaches  
14 communicating with the participants (the equivalent of web  
15 servers in Brendel et al.) from the main server (the  
16 scheduler) with the standard IP (Internet Protocol) protocol  
17 so that the present invention can reside where there is no  
18 specialized frame relay or ISDN or leased line communication  
19 between the scheduler and the participant and when there is  
20 only a standard Internet connection that is using the Internet  
21 backbone, which Brendel et al. simply cannot do.

22 As can be seen, Brendel et al. teaches away from the  
23 present invention, a fact that must be considered in  
24 determining obviousness, as was decided in General Tire and  
25 Rubber Co. v. Firestone Tire and Rubber Co., 174 USPQ at 445,  
26 where the Court held:

27 "In assessing the  
28 prior art, the Court  
29 must have regard for  
30 all of the signposts  
31 contained in it. It  
32 must consider the  
33 passages and  
34 references which  
35 point away from the  
36 invention as well as  
37 those said to point



1                   toward     it..."  
2                   [Emphasis added]"

3           To properly apply the decisional law of General Tire and  
4 Rubber Co. v. Firestone Tire and Rubber Co., one must first  
5 define what is considered "teaching away." The definition of  
6 "teaching away" was succinctly expressed in United States v.  
7 Adams, 383 U.S. 39, 52, 148 USPQ 479,484, 15 L.Ed.2D 572, 86  
8 S.Ct. 708 (1966); and W.L. Gore & Assoc., v. Garlock, Inc.,  
9 721 F.2d 1540, 1550-51, 220 USPQ 303, 311 (Fed. Cir. 1983),  
10 cert. denied, 469 U.S. 851 (1984), where the Court held:

11                   "a reference teaches  
12                   away if it suggests  
13                   that the line of  
14                   development flowing  
15                   from the reference's  
16                   disclosure     is  
17                   unlikely to be  
18                   productive of the  
19                   result sought by the  
20                   applicant." [Emphasis  
21                   added]

22           The connection between the load balancer and the server  
23 of Brendel et al. being through a discrete and/or distinct  
24 and/or dedicated connection that is independent of the  
25 Internet results in the servers not being able to be located  
26 anywhere in the world regardless of where in the world the  
27 load balancer is located and is therefore non-productive in  
28 producing the connection between the main server and the at  
29 least one participant server of the present invention being  
30 through the Internet which results in the at least one  
31 participant server being able to be located anywhere in the  
32 world regardless of where in the world the main server is  
33 located. Therefore, pursuant to W.L. Gore & Assoc., v.  
34 Garlock, Inc. discussed supra, Brendel et al. teach away from  
35 the present invention.

1           Brendel et al. would therefore lead a reader in a path  
2           divergent from the path that was taken by appellant and  
3           therefore "teaches away" from the present invention and can  
4           not be used to create a prima facie case of obviousness, as  
5           was decided in In re Gurley, 27 F.3d 551, 31, 31 USPQ.2d at  
6           1130 (Fed. Cir. 1994), where the Court held:

7                       "a reference may be  
8                       said to teach away  
9                       when a person of  
10                      ordinary skill, upon  
11                      reading the  
12                      reference would be  
13                      led in a direction  
14                      divergent from the  
15                      path that was taken  
16                      by the applicant  
17                      ...a reference that  
18                      "teaches away" can  
19                      not create a prima  
20                      facie case of  
21                      obviousness. "  
22                      [Emphasis added]

23           The signposts of Brendel et al. that teach away from the  
24           present invention must be considered in creating a holding of  
25           obviousness, as required by General Tire and Rubber Co. v.  
26           Firestone Tire and Rubber Co., United States v. Adams, W.L.  
27           Gore & Assoc., v. Garlock, Inc., and In re Gurley discussed  
28           supra which when analyzed will clearly indicate that the  
29           Examiner's combination is improper.

30           With regard to advantageous distinctive features b) and  
31           d) of claims 1 and 4, respectively, discussed supra, applicant  
32           respectfully draws the Examiner's attention to the fact that  
33           the Federal Circuit holds that relevant case law must be  
34           relied upon in determining obviousness ipso facto the  
35           determination of obviousness is a matter of law, as was

1 decided in In re Deuel, 51 F.3d 1552, 1557, 34 USPQ.2d (BNA)  
2 1210, 1214 (Fed. Cir. 1995), where the Court held:

3 "Obviousness is a  
4 question of law,  
5 which we review de  
6 novo, though factual  
7 findings underlying  
8 the Board's  
9 obviousness  
10 determination are  
11 reviewed for clear  
12 error. In re  
13 Vaeck, 947 F.2d 488,  
14 493, 20 USPQ2d 1438,  
15 1442 (Fed. Cir.  
16 1991); In re  
17 Woodruff, 919 F.2d  
18 1575, 1577, 16  
19 USPQ2d 1934, 1935  
20 (Fed. Cir. 1990)."  
21 [at 1214] [Emphasis  
22 added]

23 And, in Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d  
24 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997), where the Court held:

25 "The difficulty with  
26 RVI's position is  
27 that, although the  
28 argument has merit  
29 when the issue is  
30 purely one of fact,  
31 it does not follow  
32 when the issue  
33 involves a question  
34 of law. It is black  
35 letter law that the  
36 ultimate question of  
37 obviousness is a  
38 question of law.  
39 "See Graham v. Deere  
40 Co., 383 U.S. 1, 17,  
41 148 USPQ 459, 467  
42 (1966) (citing Great  
43 A. & P. Tea Co. v.  
44 Supermarket Equip.

1 Co., 340 U.S. 147,  
2 155, 87 USPQ 303,  
3 309 (1950)); In re  
4 Donaldson Co., 16  
5 F.3d 1189, 1192, 29  
6 USPQ2d 1845, 1848  
7 (Fed. Cir. 1994) (en  
8 banc); Texas  
9 Instruments Inc. v.  
10 Unit States Int'l  
11 Trade Comm'n, 988  
12 F.2d 1165, 1178, 26  
13 USPQ2d 1018, 1028  
14 (Fed. Cir. 1993).  
15 And we review that  
16 legal question  
17 without deference to  
18 the trial court.  
19 See Gardner V. TEC  
20 Sys. Inc., 725 F.2d  
21 1338, 1344, 220 USPQ  
22 777, 782 (Fed. Cir.  
23 1984) (district  
24 court's conclusion  
25 on obviousness "is  
26 one of law and  
27 subject to full and  
28 independent review  
29 in this court"). "[at  
30 1183] [Emphasis  
31 added]

32 In the seminal case of Graham v. John Deere Co., 383 U.S.  
33 1, 17, 148 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684  
34 (1966), the Supreme Court articulated the requirements for a  
35 prima facie holding of obviousness. The Patent Office has  
36 since set forth in MPEP 706.02 a three step requirement for  
37 establishing a prima facie case of obviousness.

38 The first step requires that the Examiner must set forth  
39 the differences in the claim over the applied references. The  
40 second step requires that the Examiner must set forth the  
41 proposed modification of the reference which would be

1 necessary to arrive at the claimed subject matter. And, the  
2 third step requires that the Examiner must explain why the  
3 proposed modification would be obvious.

4 The Courts require that in order to satisfy the third  
5 step for establishing a prima facie case of obviousness, the  
6 Examiner must identify where the prior art. provides a  
7 motivating suggestion to make the modifications proposed in  
8 the second step for establishing a prima facie case of  
9 obviousness, as was expressed in the 1992 Federal Circuit  
10 Court decision in In re Jones, 958, F.2d 347, 21 USPQ.2d 1941,  
11 where the Court held:

12 "Contention that one  
13 skilled in the  
14 herbicidal art would  
15 have been motivated  
16 to use, with acid  
17 commonly known as  
18 " d i c a m b a , "  
19 substituted ammonium  
20 salt such as that  
21 disclosed in two  
22 prior references  
23 does not warrant  
24 holding that claimed  
25 substituted ammonium  
26 salt of dicamba for  
27 use as herbicide is  
28 prima facie obvious,  
29 since there is no  
30 suggestion for  
31 c o m b i n i n g  
32 disclosures of those  
33 references either in  
34 r e f e r e n c e s  
35 themselves, which  
36 are directed to  
37 shampoo additives  
38 and production of  
39 m o r p h o l i n e ,  
40 respectively, or in  
41 knowledge generally

1                   available to those  
2                   skilled in the  
3                   art. " [ a t  
4                   1941 ] [ Emphasis  
5                   added]

6                   "The       Solicitor  
7                   points out that,  
8                   given the breadth of  
9                   forms of dicamba  
10                  (free acid, ester,  
11                  or salt) disclosed  
12                  by Richter as having  
13                  herbicidal utility,  
14                  one of ordinary  
15                  skill in the art  
16                  would appreciate  
17                  that the dicamba  
18                  g r o u p       h a s  
19                  significance with  
20                  respect to imparting  
21                  herbicidal activity  
22                  t o     d i c a m b a  
23                  compounds.       Thus,  
24                  the solicitor  
25                  contends,     one  
26                  skilled in the art  
27                  would have been  
28                  motivated to uses,  
29                  with dicamba,  
30                  substituted ammonium  
31                  salts made from a  
32                  known amine, such as  
33                  the amine disclosed  
34                  by Zorayan and  
35                  Wideman, and would  
36                  have expected such a  
37                  salt to have  
38                  herbicidal activity.  
39                  Before the PTO may  
40                  combine the  
41                  disclosures of two  
42                  or more prior art  
43                  references in order  
44                  to establish prima  
45                  facie obviousness,  
46                  there must be some

1 suggestion for doing  
2 so, found either in  
3 the references  
4 themselves or in the  
5 knowledge generally  
6 available to one of  
7 ordinary skill in  
8 the art." In re  
9 Fine, 837 F.2d 1071,  
10 1074, 5 USPQ2d 1596,  
11 1598-99 (Fed. Cir.  
12 1988). We see no  
13 such suggestion in  
14 Zorayan, which is  
15 directed to shampoo  
16 additives, nor  
17 Wideman, which  
18 teaches that the  
19 amine used to make  
20 the claimed compound  
21 is a byproduct of  
22 the production of  
23 morpholine. Nor  
24 does the board  
25 disclosure of  
26 Richter fill the  
27 gap, for the reasons  
28 discussed above."[at  
29 1943] [Emphasis  
30 added]

31 And, in Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 912  
32 F.Supp. 422, 38 USPQ.2d 1300 (W.D.Ark. 1996), where the Court  
33 held:

34 "The existence of  
35 separate elements of  
36 the invention in the  
37 prior art is  
38 insufficient to  
39 e s t a b l i s h  
40 obviousness, absent  
41 some teaching or  
42 suggestion in the  
43 prior art to combine  
44 t h e

1 elements." [Emphasis  
2 added]

3 And, in Gambro Lundia AB v. Baxter Healthcare  
4 Corporation, 110 F.3d 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997),  
5 where the court held:

6 "Without a  
7 suggestion or  
8 teaching to combine,  
9 a case of  
10 obviousness is  
11 deficient." [Emphasis  
12 added]

13 The Courts further require, however, that even if the  
14 prior art may be modified as suggested by the Examiner, the  
15 modification is not made obvious unless the prior art suggests  
16 the desirability of the modification, as was expressed in the  
17 1992 Federal Circuit Court decision in In re Fritch, 922, F.2d  
18 1260, 23 USPQ.2d 1780, where the Court held:

19 "Mere fact that  
20 prior art may be  
21 modified to reflect  
22 features of claimed  
23 invention does not  
24 make modification,  
25 and hence claimed  
26 invention, obvious  
27 unless desirability  
28 of such modification  
29 is suggested by  
30 prior art ...." [at  
31 1780] [Emphasis  
32 added]

33 "The mere fact that  
34 the prior art may be  
35 modified in the  
36 manner suggested by  
37 the Examiner does  
38 not make the  
39 modification obvious  
40 unless the prior art



1 suggested the  
2 desirability of the  
3 modification. In re  
4 Gordon, 733 F.2d at  
5 902, 221 USPQ at  
6 1 1 2 7 . " [ a t  
7 1 7 8 3 ] [ Emphasis  
8 added]

9 And further, the Fritch Court at 1783 held that the  
10 patent applicant may attack the Examiner's prima facie  
11 determination as improperly made out and tending to support  
12 a conclusion of nonobviousness:

13 "In proceedings  
14 before the Patent  
15 and Trademark  
16 Office, the Examiner  
17 bears the burden of  
18 establishing a prima  
19 facie case of  
20 obviousness based  
21 upon the prior  
22 art...[The Examiner]  
23 can satisfy this  
24 burden only by  
25 showing some  
26 objective teaching  
27 in the prior art or  
28 that knowledge  
29 generally available  
30 to one of ordinary  
31 skill in the art  
32 would lead to that  
33 individual to  
34 combine the relevant  
35 teachings of the  
36 references. The  
37 patent applicant may  
38 then attack the  
39 Examiner's prima  
40 facie determination  
41 as improperly made  
42 out, or the  
43 applicant may  
44 present objective

1 evidence tending to  
2 support a conclusion  
3 of nonobviousness."  
4 [Emphasis added]

5 In this same regard, the Examiner's attention is  
6 respectfully drawn to the decisions in Heidelberger  
7 Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21  
8 F.3d 1068, 30 USPQ.2d 1377; In re Fine, 837 F.2d 1071, 5  
9 USPQ.2d 1596 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 208  
10 USPQ 871 (CCPA 1981); and In re Merck & Co., Inc., 800 F.2d  
11 1091, 231 USPQ 375 (Fed. Cir. 1986).

12 In properly applying the Graham v. John Deere Co. test  
13 in light of, inter alia, In re Jones, and In re Fritch  
14 discussed supra, the Examiner must conduct a rigorous  
15 examination and analysis of the prior art. It would appear  
16 that the Examiner has not done so.

17 Neither Brendel et al., Leighton et al, nor for that  
18 matter any of the references cited by the Examiner, make any  
19 motivating suggestion that, inter alia the system of Brendel  
20 et al. can be modified to incorporate the teachings of  
21 Leighton et al, as suggested by the Examiner.

22 The Examiner has merely combined elements in a piecemeal  
23 manner in light of appellant's disclosure to show obviousness  
24 by using appellant's own specification as though it were prior  
25 art and in doing so has violated the basic mandate inherent  
26 in 35 U.S.C. 103, as was decided in In re Kamm and Young, 17  
27 USPQ 298 ff, where the Court held:

28 "The rejection here  
29 runs afoul of a  
30 basic mandate  
31 inherent in section  
32 103 - that a  
33 p i e c e m e a l  
34 reconstruction of  
35 the prior art

1 patents in the light  
2 of appellants'  
3 disclosure shall not  
4 be the basis for a  
5 holding of  
6 obviousness. "  
7 [Emphasis added]

8 And, in In re Stephens, Wenzl, and Browne, 145 USPQ 656  
9 (CCPA 1965), where the Court reversed a rejection on a  
10 combination of references and held:

11 "References may not  
12 be combined  
13 indiscriminately and  
14 with guidance from  
15 applicant's  
16 disclosure to show  
17 that the claims are  
18 unpatentable." [at  
19 656] [Emphasis added]

20 " I n o u r  
21 consideration of the  
22 record in light of  
23 appellants'  
24 arguments, we find  
25 nothing which  
26 demonstrates that  
27 the examiner and the  
28 board erred in  
29 rejecting the  
30 claims. While we  
31 agree with  
32 appellants that  
33 references may not  
34 be combined  
35 indiscriminately and  
36 with guidance from  
37 appellants'  
38 disclosure to show  
39 that claims are  
40 unpatentable, we  
41 think the  
42 combination of  
43 references her is  
44 proper and

1 adequately suggests  
2 the structure  
3 appellants have  
4 achieved."[at 657]  
5 [Emphasis added]

6 And, in Panduit Corp. v. Burndy Corporation et al., 180  
7 USPQ 498 (District Court, N.D. Illinois, E. Div.), where the  
8 Court held:

9 "Inquiry into the  
10 patentability must  
11 be directed toward  
12 subject matter as a  
13 whole and not to  
14 elements of a  
15 combination and  
16 their individual  
17 novelty; combination  
18 which results in a  
19 more facile,  
20 economical, or  
21 efficient unit, or  
22 which provides  
23 results unachieved  
24 by prior art  
25 structures, cannot  
26 be anticipated  
27 piecemeal by showing  
28 that elements are  
29 individually old."  
30 [at 498] [Emphasis  
31 added]

32 "The inquiry into  
33 the patentability  
34 must be directed  
35 toward the subject  
36 matter as a whole  
37 and not to the  
38 elements of the  
39 claimed combination  
40 and their individual  
41 novelty, and  
42 therefore a patented  
43 combination which  
44 results in a more

1 facile, economical  
2 or efficient unit,  
3 or which provides  
4 results unachieved  
5 by prior art  
6 structures, cannot  
7 be anticipated  
8 piecemeal by showing  
9 that the various  
10 elements of the  
11 invention are  
12 individually old.  
13 The difference  
14 between the subject  
15 matter set forth in  
16 the Re. 26,492  
17 patent and the  
18 subject matter of  
19 the cited prior art  
20 references as a  
21 whole would not have  
22 been obvious at the  
23 time the invention  
24 was made to a person  
25 of ordinary skill in  
26 the art to which  
27 such subject matter  
28 pertains, under 35  
29 U.S.C. 103.[at 505]  
30 [Emphasis added]

31 And, in Monarch Knitting Mach. Corp. v. Sulzer Morat  
32 GmbH, 139 F.3d 877, 45 USPQ.2d 1977 (Fed. Cir. 1998), where  
33 the Court held:

34 "Federal district  
35 court's formulation  
36 of problem  
37 confronting  
38 inventors of needles  
39 for automatic  
40 knitting machine  
41 presumes their  
42 solution to problem,  
43 namely modification  
44 of "stem segment" of  
45 needles; defining

1 problem in terms of  
2 its solution reveals  
3 improper hindsight  
4 in selection of  
5 prior art relevant  
6 to obviousness,  
7 resulted in district  
8 court adopting  
9 overly narrow view  
10 of scope of prior  
11 art, and infected  
12 district court's  
13 determinations about  
14 content of prior  
15 art. " [ a t  
16 1978 ] [ Emphasis  
17 added]

18 "To ascertain the  
19 scope of the prior  
20 art, a court  
21 examines "the field  
22 of the inventor's  
23 e n d e a v o r , "  
24 Shatterproof Glass  
25 Corp. v. Libbey-  
26 Owens Ford Co., 758  
27 F.2d 613, 620, 225  
28 USPQ 634, 628 (Fed.  
29 Cir. 1985), and  
30 "the particular  
31 problem with which  
32 the inventor was  
33 i n v o l v e d , "  
34 Stratoflex, Inc. v.  
35 Aerquip Corp., 713  
36 F.2d 1530, 1535, 218  
37 USPQ 871, 876 (Fed.  
38 Cir. 1983) (quoting  
39 In re Wood 599 F.2d  
40 1032, 1036, 202 USPQ  
41 171, 174 (CCPA  
42 1979)), at the "time  
43 the invention was  
44 made," see 35 U.S.C.  
45 § 103(a). The  
46 district court

1 defined the problem  
2 as "designing the  
3 stem segment of a  
4 k n i t t i n g  
5 needle...[to]  
6 minimize[] needle  
7 head breakage and  
8 thus maximize[] the  
9 operating speed of  
10 an industrial  
11 knitting machine."  
12 (emphasis added).  
13 The '053 patent, on  
14 the other hand,  
15 describes the  
16 inventor's problem  
17 as "providing  
18 [knitting needles]  
19 with a means which  
20 avoids head  
21 breakages or lets  
22 [breakages] start to  
23 an extent worth  
24 mentioning only at  
25 higher knitting  
26 speeds." '053  
27 patent, col. 1,  
28 lines 48-51. The  
29 district court's  
30 formulation of the  
31 problem confronting  
32 the '053 inventors  
33 presumes the  
34 solution to the  
35 p r o b l e m -  
36 modification of the  
37 stem segment.  
38 defining the problem  
39 in terms of its  
40 solution reveals  
41 improper hindsight  
42 in the selection of  
43 the prior art  
44 relevant to  
45 obviousness. See,  
46 e.g. In re Antle,  
47 444 F.2d 1168, 1171-

1 72, 170 USPQ 285,  
2 287-88 (CCPA 1971)  
3 (warning against  
4 selection of prior  
5 art with hindsight).  
6 By importing the  
7 ultimate solution  
8 into the problem  
9 facing the  
10 inventors, the  
11 district court  
12 adopted an overly  
13 narrow view of the  
14 scope of the prior  
15 art. It also  
16 infected the  
17 district court's  
18 determinations about  
19 the content of the  
20 prior art." [at  
21 1981] [Emphasis  
22 added]

23 And, in In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453  
24 (Fed. Cir. 1998), where the Court reversed the Board's  
25 decision in which the level of skill in the art being high was  
26 not sufficient to supply motivation:

27 "Three possible  
28 sources for  
29 motivation to  
30 combine prior art  
31 references in manner  
32 that would render  
33 claimed invention  
34 obvious are nature  
35 of problem to be  
36 solved, teachings of  
37 prior art, and  
38 knowledge of persons  
39 of ordinary skill in  
40 art; high level of  
41 skill in field of  
42 art cannot be relied  
43 upon to provide  
44 necessary motivation



1 absent explanation  
2 of what specific  
3 understanding or  
4 technical principle,  
5 within knowledge one  
6 of ordinary skill in  
7 art, would have  
8 suggested  
9 combination, since  
10 if such rote  
11 invocation could  
12 suffice to supply  
13 motivation to  
14 combine, more  
15 sophisticated  
16 scientific fields  
17 would rarely, if  
18 ever, experience  
19 patentable technical  
20 advance. " [ a t  
21 1453 ] [ Emphasis  
22 added]

23 "Claimed low orbit  
24 s a t e l l i t e  
25 communication system  
26 for mobile terminals  
27 is not prima facie  
28 obvious over  
29 combination of two  
30 p r i o r a r t  
31 references, even  
32 though person  
33 possessing high  
34 level of skill  
35 characteristic of  
36 this field would  
37 know to account for  
38 differences between  
39 claimed invention  
40 and prior art  
41 combination, since  
42 high level of skill  
43 in art, without  
44 more, cannot supply  
45 required motivation  
46 to combine

1 references, and does  
2 not overcome absence  
3 of any actual  
4 suggestion to  
5 combine; obviousness  
6 rejection will not  
7 be upheld, even  
8 where skill in art  
9 is high, absent  
10 s p e c i f i c  
11 identification of  
12 principle, known to  
13 one of ordinary  
14 skill, that suggests  
15 c l a i m e d  
16 combination." [at  
17 1454] [Emphasis  
18 added]

19 The Examiner's use of improper hindsight by using  
20 applicant's own disclosure as though it was prior art is  
21 established beyond a reasonable doubt by the Examiner's own  
22 admission in the Examiner's rational for why the proposed  
23 modification would be obvious, which is stated at page 6,  
24 paragraph 2, lines 3-12 of the last Office Action cited infra:

25 "...for the purpose  
26 of allowing the  
27 hosting scheme to be  
28 far more efficient  
29 than schemes that  
30 cache everything  
31 elsewhere, or that  
32 cache objects only  
33 in pre-specified  
34 locations (Leighton,  
35 col. 3, lines 42-57)  
36 and unlimited cost  
37 e f f e c t i v e  
38 s c a l a b i l i t y  
39 (Leighton, col. 14,  
40 line 62 - col. 15,  
41 line 13). Leighton  
42 also suggests that  
43 c o n t e n t i s

1                   automatically  
2                   replicated to the  
3                   global server  
4                   network in an  
5                   intelligent and  
6                   efficient fashion.  
7                   Content is  
8                   replicated in only  
9                   those locations  
10                   where it is needed  
11                   (Leighton, col. 4,  
12                   lines 25-49).  
13                   Leighton also  
14                   suggests that  
15                   improving the Web  
16                   site performance and  
17                   avoiding the  
18                   expensive backbone  
19                   links to carry  
20                   redundant traffic  
21                   from the Content  
22                   Provider's Web site  
23                   to the network  
24                   exchange and access  
25                   points (Leighton,  
26                   col. 13, line 762 -  
27                   col. 14, line  
28                   49). " [ Emphasis  
29                   added]

30           Throughout applicant's disclosure applicant makes  
31           constant reference to the novelty of the present invention  
32           being "to save costs by virtue of the at least one participant  
33           server being relatively easy and inexpensive to add as  
34           compared to clustering more servers to the main server," for  
35           example in the claim:

36                   "downloading       the  
37                   r e q u e s t e d  
38                   information       from  
39                   said main server to  
40                   said at least one  
41                   nearest participant  
42                   server, which will  
43                   distribute the load

1 of said main server  
2 to said at least one  
3 participant server  
4 when lacking  
5 multicasting so as  
6 to save costs, by  
7 virtue of said at  
8 least one  
9 participant server  
10 being relatively  
11 easy and inexpensive  
12 to add as compared  
13 to clustering more  
14 servers to said main  
15 server" [Emphasis  
16 added

17 So applicant has shown supra that the Examiner has used  
18 applicant's own disclosure as though it was prior art, and by  
19 doing so, has used improper hindsight in the rational for why  
20 the proposed modification would be obvious, and as a result  
21 thereof, pursuant to In re Kamm and Young, In re Stephens,  
22 Wenzl, and Browne, Panduit Corp. v. Burndy Corporation et al.,  
23 Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, and In re  
24 Rouffet discussed supra, the proposed modification cannot be  
25 used for a holding of obviousness.

26 Applicant has provided clear and convincing evidence that  
27 neither Brendel et al., Leighton et al., nor for that matter  
28 any of the references cited by the Examiner, accomplish  
29 appellant's result of providing an efficient Internet system  
30 that, inter alia:

- 31 1. Enables the at least one participant server to be located  
32 anywhere in the world regardless of where in the world  
33 the main server is located.
- 34 2. Eliminates a need for costly multicasting if the at least  
35 one participant server does not contain the requested  
36 information.

1 Therefore a holding of obviousness cannot be made out,  
2 as was decided by the Board of Appeals in Ex parte Tanaka,  
3 Marushima and Takahashi, 174 USPQ 38, where the Board held:

4 "Claims are not  
5 rejected on the  
6 ground that it would  
7 be obvious to one of  
8 ordinary skill in  
9 the art if the prior  
10 art devices do not  
11 accomplish  
12 applicant's  
13 result." [Emphasis  
14 added]

15 And, in In re Wright, 122 USPQ 522 (1959), where the  
16 Court held:

17 "...the mere  
18 aggregation of old  
19 elements that did  
20 not perform a  
21 different function  
22 is not a patentable  
23 invention, but that  
24 a novel combination  
25 of old elements  
26 which cooperate with  
27 each other to  
28 produce a new or  
29 useful result or a  
30 substantial increase  
31 in efficiency is  
32 patentable." [Emphas  
33 is added]

34 And, further in the en banc decision in In re Dillon, 919  
35 F.2d 688, 692 (Fed. Cir. 1990), where the Court held:

36 "...a prima facie  
37 case of obviousness  
38 requires that the  
39 prior art suggest  
40 the claimed  
41 compositions'  
42 properties and the

1                    problem        the  
2                    applicant    attempts  
3                    to solve." [Emphasis  
4                    added]

5            In this same regard, the Examiner's attention is  
6            respectfully directed to the decisions in In re Halleck, 164  
7            USPQ 647 (CCPA 1970); and Kockum Industries, Inc. v. Salem  
8            Equipment, Inc., 175 USPQ 81 (9th Cir. 1972).

9            In light of, inter alia In re Miller, In re Fuetterer,  
10           In re Ludke and Sloan, In re Chu, Schnell et al. v. The  
11           Allbright-Nell Company et al., Ex parte Grasenick and Gessner,  
12           Mercantile National Bank of Chicago et al v. Quest, Inc. et  
13           al. DC., N.D. Indiana, In re Shelby, In re Irani and  
14           Moedritzer, General Tire and Rubber Co. v. Firestone Tire and  
15           Rubber Co., United States v. Adams, W.L. Gore & Assoc., v.  
16           Garlock, Inc., In re Gurley, In re Deuel, Richardson-Vicks  
17           Inc. v. The Upjohn Co., the Graham v. John Deere Co. test in  
18           light of, inter alia MPEP 706.02, In re Jones, Arkie Lures,  
19           Inc. v. Gene Larew Tackle, Inc., Gambro Lundia AB v. Baxter  
20           Healthcare Corporation, In re Fritch, Heidelberger  
21           Druckmaschinen AG v. Hantscho Commercial Products, Inc., In  
22           re Fine, In re Keller, and In re Merck & Co., Inc., In re Kamm  
23           and Young, In re Stephens, Wenzl, and Browne, Panduit Corp.  
24           v. Burndy Corporation et al., Monarch Knitting Mach. Corp. v.  
25           Sulzer Morat GmbH, In re Rouffet, Ex parte Tanaka, Marushima  
26           and Takahashi, In re Wright, In re Dillon, In re Halleck, and  
27           Kockum Industries, Inc. v. Salem Equipment, Inc. discussed  
28           supra, pursuant to In re Fritch discussed supra appellant  
29           attacks the Examiner's prima facie determination as being  
30           improperly made out and tending to support a conclusion of  
31           nonobviousness.

1 In view of the arguments presented supra, appellant  
2 respectfully submits that the Examiner's grounds for the  
3 Examiner's rejection of claims 1-6 under 35 U.S.C. 103(a) over  
4 Brendel et al. in view of Leighton et al. are no longer  
5 tenable and appellant therefore respectfully requests that the  
6 Examiner withdraw the rejection.

7 In view of the above, it is submitted that the claims are  
8 in condition for allowance. Reconsideration and withdrawal  
9 of the rejections are requested. Allowance of claims 1-6 at  
10 an early date is earnestly solicited.

11 Respectfully submitted,

12 Richard L. Miller  
13 12 Parkside Drive  
14 Dix Hills, N.Y. 11746-4879  
15

BY:   
Richard L. Miller  
Agent for Applicant

16 PHONE NUMBER: (631) 499-4343

Date: June 9, 2003